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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,108	09/23/2003	Roger Daugherty	21590-CIP	3118
30184	7590	11/16/2004	EXAMINER	
MYERS & KAPLAN, INTELLECTUAL PROPERTY LAW, L.L.C. 1899 POWERS FERRY ROAD SUITE 310 ATLANTA, GA 30339			PATEL, NIHIR B	
			ART UNIT	PAPER NUMBER
			3743	

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/669,108

Applicant(s)

DAUGHERTY, ROGER

Examiner

Nihir Patel

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on September 8<sup>th</sup>, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,14,15,17-20,22 and 23 is/are rejected.
- 7) ☒ Claim(s) 9-13,16,21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., wherein such condensed moisture accumulated within the tube from prior patient exhalations) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. US Patent No. 6,536,428. Referring to claim 1, Smith discloses a ventilation system and/or breathing tube that comprises a reverse flow adaptor, the reverse flow adaptor to be coupled to the unilimb breathing circuit for permitting the respiratory gas to flow through an outer tube of the unilimb breathing circuit for interaction with and humidification by condensed moisture disposed therewithin, and wherein patient expired gases flow through an inner tube of the unilimb breathing circuit and exit through an aperture formed in the reverse flow adapter.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The intended use statements are not given any patentable weight in this instance for example “for permitting the inspiratory gas to flow through an outer tube of the unilimb breathing circuit for interaction with and humidification by condensed moisture disposed therewithin”.

Referring to claim 5, Smith discloses a ventilation system and/or breathing tube that comprises a reverse flow adaptor comprising a venting aperture, the reverse flow adaptor adapted to be coupled to an inner tube and an outer tube of the unilimb breathing circuit, wherein the inspiratory gas flows through the reverse flow adaptor and subsequently through the outer tube of the unilimb breathing circuit, and wherein the venting aperture is in fluid communication with the inner tube of the unilimb breathing circuit.

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The intended use statements are not given any patentable weight in this instance for example “for permitting the inspiratory gas to flow through an outer tube of the unilimb breathing circuit for interaction with and humidification by condensed moisture disposed therewithin”.

Referring to claim 6, Smith discloses an apparatus wherein the outer tube is coaxially disposed about the inner tube of the unilimb breathing circuit.

Referring to claim 7, Smith discloses an apparatus wherein the outer tube retains moisture deposited therein via condensation of moisture from patient expiratory gasses.

Referring to claim 8, Smith discloses an apparatus wherein the reverse flow adaptor is adapted to be coupled to a conventional inspiratory gas source.

Referring to claim 17, Smith discloses a ventilation system and/or breathing tube that comprises a reverse flow adaptor comprising a venting aperture, the reverse flow adaptor adapted to be coupled to the unilimb breathing circuit.

Referring to claim 18, Smith discloses an apparatus wherein the reverse flow adaptor comprises an inlet, the venting aperture formed through the inlet, and wherein the inlet further comprises a flow aperture for permitting respiratory gases flowing from a central inspiratory gas source to flow therethrough and pass through the inlet.

Referring to claim 19, Smith discloses an apparatus wherein the inlet is adapted to an outer expiratory tube of the unilimb breathing circuit, resulting in the flow aperture being in fluid communication with an inner space of the outer expiratory tube, and wherein the venting aperture is in fluid communication with an inner space of an inner inspiratory tube of the unilimb breathing circuit.

Referring to claim 20, Smith discloses an apparatus wherein inspiratory gases flowing from a central inspiratory gas source flow through the flow aperture of the reverse flow adaptor, into the inlet of the reverse flow adaptor, and through the inner space of the outer expiratory tube.

Referring to claim 22, Smith discloses an apparatus wherein patient exhaled gas flows through the inner inspiratory tube of the unilimb breathing circuit and exit from the venting aperture of the reverse flow adaptor.

Referring to claim 23, Smith discloses a ventilating system and/or breathing tube that comprises the steps of coupling a reverse flow adaptor to an outer tube expiratory tube of the unilimb breathing circuit; directing a stream of gas through the outer expiratory tube via the reverse flow adaptor; humidifying the stream of gas with condensed moisture disposed within the outer expiratory tube, and permitting patient expired gases to travel through an inner inspiratory tube of the unilimb circuit for exiting through an aperture formed in the reverse flow adaptor.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. US Patent No. 6,536,428 in view of Needham US Patent No. 3,995,625. Smith discloses the applicant's invention as claimed with the exception of providing a flow diluter.

Needham discloses a inhalation devices that does provide a flow diluter. Therefore it would be obvious to one in the ordinary skill of the art to modify Smith's invention by providing a flow diluter in order to improve the breathing procedure.

***Allowable Subject Matter***

Claims 9, 10 through 13, 16, and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Nihir Patel whose telephone number is (703) 306-3463. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful the examiner supervisor Henry Bennett can be reached at (703) 308-0101.

NP  
November 15<sup>th</sup>, 2004

  
Henry Bennett  
Supervisory Patent Examiner  
Group 3700